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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,845	07/29/2005	Terje Angelskaar	MBZ-0503	4363
23575 7590 04/14/2009 CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145				
EXAMINER GOLOBOY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,845

Applicant(s)

ANGELSKAAR, TERJE

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 1/9/09 overcomes the rejections set forth in the office action mailed 9/15/08. Applicant's arguments regarding claim 1 and its dependent claims are persuasive and new grounds of rejection for those claims are set forth below.

Claim Rejections - 35 USC § 103

2. Claims 1-2, 4-10, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto in view of Grier and Jonnes.

The rejections of claims 2, 7-10, and 14-18 are adequately set forth in paragraph 5 of the office action mailed 9/15/08, which is incorporated here by reference. It is further noted that the only process step recited in claims 1 and 4-6 is the application of the lubricating composition to a metal tube, which is taught by Matsumoto. Claims 1 and 4-6 are therefore rendered obvious as well.

3. Claims 3 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto in view of Grier and Jonnes as applied to claims 1-2, 4-10, and 14-18 above, and further in view of Kuwamoto.

This rejection is adequately set forth in paragraph 6 of the office action mailed 9/15/08, which is incorporated here by reference.

Response to Arguments

4. Applicant's arguments regarding the rejections of claims 1 and 4-6 in the previous office action are persuasive. However, as noted above, Matsumoto, Grier, and Jonnes do disclose applying the lubricant to a metal tube, which is the only process step recited in claim 1.

Applicant's arguments regarding claim 2 and its dependent claims are not persuasive. Claim 2 recites a composition consisting essentially of a solid mixture of components. Matusomoto, Grier, and Jonnes disclose an aqueous composition containing these components. However, the water present in this aqueous composition clearly does not affect the basic and novel characteristics of the claimed composition, because the claimed composition is intended to be added to water and used as an aqueous lubricant. It is noted that while the lubricating composition of claim 2 consists essentially of a solid mixture, it is not required to be a solid lubricating composition.

Applicant's arguments regarding claim 14 and its dependent claims are similarly not persuasive. The composition of Matsumoto, Grier, and Jonnes comprises the solid mixture. The claim does not require the lubricating composition to be solid.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797